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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,542	05/13/2005	6331415	22338-10230	7585

47554 7590 02/25/2008

SIDLEY AUSTIN LLP  
ATTN: DC PATENT DOCKETING  
1501 K STREET, NW  
WASHINGTON, DC 20005

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 02/25/2008

Please find below and/or attached an Office communication concerning this application or proceeding.



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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

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**EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. 90/007,542.

PATENT NO. 6331415.

ART UNIT 3991.

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified *ex parte* reexamination proceeding (37 CFR 1.550(f)).

Where this copy is supplied after the reply by requester, 37 CFR 1.535, or the time for filing a reply has passed, no submission on behalf of the *ex parte* reexamination requester will be acknowledged or considered (37 CFR 1.550(g)).

PTOL-465 (Rev.07-04)

Sanofi/Regeneron Ex. 1017, pg 499

<b>Office Action in Ex Parte Reexamination</b>	<b>Control No.</b> 90/007,542	<b>Patent Under Reexamination</b> 6331415	
	<b>Examiner</b> Bennett Celsa	<b>Art Unit</b> 3991	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

- a  Responsive to the communication(s) filed on 21 May 2007.                      b  This action is made FINAL.  
c  A statement under 37 CFR 1.530 has not been received from the patent owner.

A shortened statutory period for response to this action is set to expire 2 month(s) from the mailing date of this letter. Failure to respond within the period for response will result in termination of the proceeding and issuance of an *ex parte* reexamination certificate in accordance with this action. 37 CFR 1.550(d). **EXTENSIONS OF TIME ARE GOVERNED BY 37 CFR 1.550(c)**. If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.

**Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:**

- |   |   |
|---|---|
| 1. <input checked="" type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 3. <input type="checkbox"/> Interview Summary, PTO-474. |
| 2. <input checked="" type="checkbox"/> Information Disclosure Statement, PTO/SB/08.     | 4. <input type="checkbox"/> _____.                      |

**Part II SUMMARY OF ACTION**

- 1a.  Claims 1-36 are subject to reexamination.  
1b.  Claims \_\_\_\_\_ are not subject to reexamination.  
2.  Claims \_\_\_\_\_ have been canceled in the present reexamination proceeding.  
3.  Claims \_\_\_\_\_ are patentable and/or confirmed.  
4.  Claims 1-36 are rejected.  
5.  Claims \_\_\_\_\_ are objected to.  
6.  The drawings, filed on \_\_\_\_\_ are acceptable.  
7.  The proposed drawing correction, filed on \_\_\_\_\_ has been (7a)  approved (7b)  disapproved.  
8.  Acknowledgment is made of the priority claim under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All b)  Some\* c)  None of the certified copies have  
1  been received.  
2  not been received.  
3  been filed in Application No. \_\_\_\_\_.  
4  been filed in reexamination Control No. \_\_\_\_\_.  
5  been received by the International Bureau in PCT application No. \_\_\_\_\_.  
\* See the attached detailed Office action for a list of the certified copies not received.  
9.  Since the proceeding appears to be in condition for issuance of an *ex parte* reexamination certificate except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte* Quayle, 1935 C.D. 11, 453 O.G. 213.  
10.  Other: \_\_\_\_\_

cc: Requester (if third party requester)

U.S. Patent and Trademark Office  
PTOL-466 (Rev. 08-06)

Office Action in Ex Parte Reexamination

Part of Paper No. 11/19/07

Art Unit: 3991

**Reexamination of US Patent No. 6,331,415 (Cabilly 2 patent).****Status of the Claims**

Claims 1-36 are pending and under reexamination. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

**Procedural Posture:**

Merger of 3rd Partly Requests 90/007,542 and 90/007,859

i. 90/007542 ('7542 Proceeding):	ii. 90/007859 ('7859 Proceeding)
Reexamination request filed:	5/13/05      12/23/05
Reexamination ordered:	7/7/05.      1/23/06
Patent Owner Statement:	none      none
First Office Action mailed:	9/13/05      N/A
Patent Owner Response dated	1/25/05      N/A
'7542 AND '7859 merged:	6/6/06

Following merger of the 90/007,542 and 90/007,859 proceedings, the First Office Action dated September 13, 2005 in the '7542 proceeding was withdrawn in light of the Non-Final Office Action dated August 16, 2006.

Patent owner's November 25, 2005 response (with Declarations) and October 30, 2006 response (with Declarations) to the September 13, 2005 and subsequent August 16, 2006 office actions, respectively in the 90/007,542 proceeding were filed.

Final rejection of claims 1-36 was mailed February 16, 2007 including raising a new ground of rejection over the Moore 5,840,545 patent included in the IDS submitted December 14, 2006 and January 16, 2007 information disclosure statements.

A Patent Owner Response After-Final rejection (dated 5/21/07) that included:

- a. 132 Declarations by Michael Botchan, Steven Lanier McNight, Mathhew P. Scott, and Sidney Altman;
- b. An Information Disclosure Statement (IDS);
- c. A Confidential Information Disclosure Statement (Artifact Sheet);
- d. Exhibit B (54 pages) Moore 06/358,414 application with original claims 1-25; and
- e. 181/182 Petition and Renewed Petition to Reopen Prosecution To Withdraw Finality or alternatively for the Filing of a Request for Continued Reexamination (RCR) is acknowledged.

Art Unit: 3991

The Petition decision of June 1, 2007 resulted in the granting of this RCR. The finality of the February 16, 2007 Office Action is hereby withdrawn, and the prosecution is reopened for consideration of the patent owner May 21, 2007 response and Declaration submissions.

#### **Information Disclosure Statement (IDS)**

The 9/6/07 IDS submitted listing references on a PTO-1449 has been considered as indicated by the enclosed Examiner-initialed copy. It is to be noted, however, that consideration by the examiner of the information submitted in an IDS means nothing more than considering the documents in the same manner as other documents in Office search files are considered by the examiner while conducting a search of the prior art in a proper field of search. See MPEP 609, at page 600-125, Revision 2, May 2004.

#### **Information Submitted Under MPEP § 724.02 in Petition Under 37 CFR 1.59 (b) and 1.182 (expunge) and 1.183 (3rd Party service):**

The owner has submitted papers on 5/21/07 and 10/24/07 deemed confidential and/or proprietary along with a petition for expungement of this material and director waiver of the 37 CFR § 1.550(f) 3rd party service requirement.

On October 9, 2007, the petition under 37 CFR 1.183 to waive the 3<sup>rd</sup> party service requirement was granted and the submitted documents provisionally sealed pending a materiality determination regarding the expungement of these documents.

Pursuant to MPEP § 724.04 the submitted information is found immaterial to the patentability and/or confirmation of the instant reexamination claims.

#### **Priority**

The 6,331,425 (Cabilly 2) patent undergoing reexamination issued on December 18, 2001 from application 07/205,419 (filed 6/10/88) which was a continuation of 06/483,457 (filed 4/8/83) now the 4,816,567 (Cabilly 1) patent.

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